

FROM THE EXAMINER TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellant : Low, et al.
App. No : 10/009,575
Filed : August 6, 2002
For : A MESSAGE PROCESSING SYSTEM
Examiner : CORRIELUS, JEAN M
Art Unit : 2162

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ON APPEAL TO THE BOARD OF PATENT APPEALS AND INTERFERENCES
APPEAL BRIEF

Mail Stop Appeal Brief -- Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Appeal Brief relates to an appeal to the Board of Patent Appeals and Interferences of the final rejection set forth in a final Office Action mailed January 3, 2008 in the above-captioned application.

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I. REAL PARTY IN INTEREST

The real party in interest in this appeal is Sydney Gordon Low.

II. RELATED APPEALS AND INTERFERENCES

Appellant is unaware of any related appeals or interferences.

III. STATUS OF THE CLAIMS

The application was originally filed with Claims 1-18 on November 9, 2001. A preliminary amendment for cancelling Claims 1-18 and adding new claims 19-36 was concurrently filed with the application. In response to a second Office Action mailed on March 7, 2004, Claims 19, 29 and 36 were amended. In response to a third Office Action mailed on January 4, 2005, Claims 19, 29-30 and 36 were amended.

In a fourth and Final Office Action (first final) mailed on June 30, 2005, the Examiner finally rejected Claims 19-36 based on Olivier, et al. (U.S. Patent No. 6,480,885) and Ogilvie, et al. (U.S. Patent No. 6,324,569).

No claim amendments were made in response to the first final Office Action. Appellant also argued in the first final Office Action response that cited portions of a main prior art reference (Ogilvie) are not in fact prior art. An Advisory Action was mailed on November 21, 2005, in which the Examiner repeated the previous claim rejections and did not address Appellant's arguments that the cited portions are not prior art. A first Notice of Appeal was filed on December 29, 2005 and an Appeal Brief was filed on February 28, 2006.

In a fifth and Final Office Action (second final) mailed on May 19, 2006, the Examiner finally rejected Claims 19-36. In a response, filed on July 19, 2006, to the second final Office Action, Claims 19, 29-30 and 36 were amended to restore the originally filed claims. A request for continued examination (RCE) was subsequently filed on August 21, 2006 so as to have the claim amendments considered.

In a sixth and non-final Office Action mailed on September 28, 2006, the Examiner rejected Claims 19-36 based on the same references (Olivier and Ogilvie). In the September 28, 2006 Office Action, the Examiner confirmed that the claim amendments filed on July 19, 2006

were entered. *See the September 28, 2006 Office Action at page 2.* In a response, filed on February 27, 2007, to the sixth Office Action, no claim amendments were made.

In a seventh and non-final Office Action mailed on March 13, 2007, the Examiner rejected Claims 19-36 based on the same references (Olivier and Ogilvie). In an eighth and non-final Office Action mailed on July 3, 2007, which appears to be the same Office Action as the March 13, 2007 Office Action, the Examiner rejected Claims 19-36 based on the same references. The U.S. Patent and Trademark Office vacated the March 13, 2007 Office Action and reset the statutory period to response from the mailing date of the July 3, 2007 Office Action.

In a response, filed on October 2, 2007, to the eighth Office Action, no claim amendments were made. In a ninth and Final Office Action (third final) mailed on January 3, 2008, the Examiner finally rejected Claims 19-36 based on the same references (Olivier and Ogilvie). In response to the third final Office Action, a second Notice of Appeal was filed on March 31, 2008.

IV. STATUS OF AMENDMENTS

The Examiner previously entered the claim amendments. Thus, Claims 19-36 are pending and appear before the Board as they were finally rejected, and the claims are attached hereto as Appendix A.

V. SUMMARY OF CLAIMED SUBJECT MATTER

As described in the application as filed, embodiments of the invention include message processing methods and systems which provide a useful alternative or allows management of unsolicited messages without seeking to simply restrict or filter incoming messages. *See Application at p. 1, l. 21 through p. 2, l. 13.*

Claim 19 recites a method of handling messages. The method comprises determining if a message is approved for a recipient of the message. *See Application at p. 3, ll. 16-17; Figure 2.* The method also comprises processing the message for subsequent viewing by the recipient if the message is approved. *See Application at p. 3, ll. 20-25; Figure 2.* Additionally, the method

includes notifying the recipient and storing the message, if the message is unapproved. *See Application at p. 3, ll. 27-28; p. 3, l. 30 through p. 4, l. 4; p. 5, ll. 3-4; Figure 2.*

Claim 29 recites a message processing system. The system comprises means for determining if a message is approved for a recipient of the message. *See Application at p. 2, ll. 25-28; p. 3, ll. 15-17; Figures 1 and 2.* The system also comprises means for processing the message for subsequent viewing by the recipient if the message is approved. *See Application at p. 2, ll. 25-28; p. 3, ll. 15-16; p. 3, ll. 20-25; Figures 1 and 2.* Additionally, the system includes means for notifying the recipient and storing the message, if the message is unapproved. *See Application at p. 2, ll. 25-28; p. 3, ll. 15-16; p. 3, ll. 27-28; p. 3, l. 30 through p. 4, l. 4; p. 5, ll. 3-4; Figures 1 and 2.*

Claim 30 recites a message processing system. The system comprises an electronic message server for receiving and storing electronic messages for a recipient. *See Application at p. 2, ll. 22-25; p. 3, ll. 15-16; p. 3, ll. 22-23; Figures 1 and 2.* The system also comprises an electronic message manager for processing electronic messages for a recipient to determine if the electronic messages are approved based on stored criteria, sending approved electronic messages for the recipient to a location for access by the recipient, and storing and sending a notification to the recipient of unapproved messages. *See Application at p. 2, ll. 25-28; p. 3, ll. 15-25; p. 3, l. 27 through p. 4, l. 4; p. 4, l. 29 through p. 5, l. 8; Figures 1 and 2.*

Claim 36 recites a computer readable storage medium having code for executing a method of handling messages method of handling messages. The method comprises determining if a message is approved for a recipient of the message. *See Application at p. 3, ll. 16-17; Figure 2.* The method also comprises processing the message for subsequent viewing by the recipient if the message is approved. *See Application at p. 3, ll. 20-25; Figure 2.* Additionally, the method includes notifying the recipient and storing the message, if the message is unapproved. *See Application at p. 3, ll. 27-28; p. 3, l. 30 through p. 4, l. 4; p. 5, ll. 3-4; Figure 2.*

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

This Appeal turns on the following issue:

Claims 19-36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Olivier, et al. (U.S. Patent No. 6,480,885) and Ogilvie, et al. (U.S. Patent No. 6,324,569).

VII. APPELLANT'S ARGUMENT

A. Claims 19-36 are patentable over Olivier and Ogilvie.

i) The Examiner's Grounds for Rejection

In the final Office Action, the Examiner stated that:

As to claim 19, Olivier discloses an analogous system that enables users to exchange group electronic mail by establishing profiles and criteria for determining personalized subsets within a group by comparing the identified appearing on the allowed list to determine whether each designated recipient is on the list for the intended recipient that stored on the database of the e-mail manager (col.17, lines 7-12). In particular, Olivier stated that if the message is not approved, the sender is notified by the system (col.14, line 56-col.15, line 15). Although, Olivier does not explicitly disclose the use of notifying the recipient if a message is unapproved. Olivier, however, stated when someone responds to a message via their email client's reply all feature, the message is addressed back to that to header field, including the encoded unique ID is extracted from the email address and it then uses the stored distribution list associated with the unique ID, rather than the sender's distribution list, so the system would automatically checking the recipient's message acceptance and unapproval criteria data. Olivier also allows the sender to modify the setting when sending a message. Such teaching of Olivier has the functional limitation of sending a notification to the recipient when a message is unapproved with respect to the message criteria data set by the sender. Once the notification is set by Olivier in the message criteria data, the recipient will automatically receives an acknowledgement as to whether a message is approved or not (see Olivier col.16, lines 25-62). Ogilvie, on the other hand, discloses an analogous system for "notifying the recipient if a message is unapproved" as a means of providing the recipient with the capability to manage unsolicited email messages without the messages inadvertently removed by a message filter, and also requesting to remove from the mailing list (col.1, lines 55-64; col.14, lines 26-39). The system of Ogilvie has the capability, both, of not requiring that recipients affirmatively remove unwanted email or create a reply message having remove in the subject to indicate their lack of

interest in the subject matter (col.11, lines 1-6) and determining whether they contain any self removing message indicators from message originators then automatically notifying the recipient according to the instruction of the replacement message (col.13, lines 1-5; col.14, lines 28-39). Therefore, it would have been obvious to one of ordinary skill in the art of data processing, at the time the present invention was made to combine the teachings of the cited references, wherein the message distribution provided therein (See Olivier's fig.10 (2)) would incorporate the use of notifying the recipient if the message is unapproved (unsolicited), in the same conventional manner as disclosed by Ogilvie (col.1, lines 55-64; col.13, lines 1-5; col.14, lines 28-39). One having ordinary skill in the art would have been motivated to utilize such a combination would provide Olivier's system the enhanced capability of managing unsolicited email messages without the messages inadvertently removed by a message filter, thereby reducing the inconvenience of unsolicited email by making it possible for officials to present messages that do not have to be manually removed by the recipient.

As to claims 29-32: Claims 29-32 are computer system performing by the method of claims 19-28 above. They are, therefore, under the same rationale. In addition, Ogilvie discloses the use of storing and sending a notification to the recipient of unapproved message (col.1, lines 46-53); an access server for generating a display page with a list of unapproved message (col.5, lines 6-45); wherein the list of unapproved messages includes links to the unapproved message respectively and which on selection causes transmission of an unapproved message to a recipient's computer device for viewing by the recipient" (col.1, lines 55-65; col.14, line 26-38).

In the "Response to Arguments" section of the third final Office Action dated January 3, 2008, the Examiner further stated that:

Applicant asserted that neither Olivier nor Ogilvie teaches or suggests the claimed "notifying the recipient if the message is unapproved". The Examiner has carefully considered the subject matter on the response, the rejections advanced by the Examiner, and the evidence of obviousness relied upon by Examiner as support for the rejections. In rejecting the claims under 35 U.S.C. 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason has stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art.

These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. The Examiner's position with respect to the assertion above is that Ogilvie discloses an email verification system for notifying the recipient if message is approved (col.14, lines 26-39). The system disclosed by Ogilvie checks the incoming messages to determine whether they contain a self-removing messaging indicator from the message originator or message distributors and automatically notifies the recipient, wherein the recipient would be automatically notified. Similarly to the description provided by the specification, page, wherein the specification states that the e-mail message is based on whether the sender of the message is on a list of approved senders for the intended recipient that is stored on the database of the e-mail manager. Therefore, removal code of Ogilvie determines whether the incoming messages contain any self-removing message indicators from message originators and/or message distributors (intended recipient list). Ogilvie also states that the check triggering criteria used by the intended recipient list allows the option to block the email or send the recipient a notification request, see col.13, lines 62-col.14, line 12). The aforementioned assertion is moot.

ii) The Legal Standard

The Patent and Trademark Office has the burden under section 103 to establish a *prima facie* case of obviousness. *In re Piasecki*, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-87 (Fed. Cir. 1984). To establish a *prima facie* case of obviousness, however, prior art (as opposed to prior art references) must teach or suggest all the claim limitations. "Examination Guidelines for Determining Obviousness Under 35 U.S.C. §103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*" Federal Register Vol. 72 No. 195 at 57528 (October 10, 2007). Further, the Patent Office must explain why the differences between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art. *Id.*

iii) Neither Olivier nor Ogilvie Teaches or Suggests the Features of Each of Pending Claims 19-36

a. Discussion of Patentability of Independent Claims 19, 20, 30 and 36

Each of independent Claims 19 and 36 recites, among other things, *notifying the recipient and storing the message, if the message is unapproved*. Each of independent Claims 29 and 30 includes similar features thereto. Appellant respectfully submits that neither Olivier nor Ogilvie teaches the above-recited features of the claimed invention.

1. Olivier does not teach or suggest “notifying the recipient and storing the message, if the message is unapproved”

Olivier does not teach the feature of “notifying the recipient and storing the message, if the message is unapproved.” The Examiner acknowledged as such in the third Final Office Action dated January 3, 2008. *See the third final Office Action at page 3, lines 3-4.*

2. Ogilvie does not remedy the deficiency of Olivier

Appellant respectfully submits that Ogilvie, having prior art status in pertinent part, does not teach or suggest the feature of “notifying the recipient and storing the message, if the message is unapproved.” Appellant would like to summarize the previous arguments and Examiner’s rejections.

Summary of Appellant’s Previous Arguments and Examiner’s Rejections

In the response submitted on July 19, 2006, Appellant argued that the passages of Ogilvie cited by the Examiner (column 1, lines 45-65; column 2, lines 1-7; column 7, lines 4-22; and column 8, lines 2-11; column 13, lines 1-5; and column 13, lines 26-39) were not disclosed in the parent applications of Ogilvie which antedate the priority date of this application (May 12, 1999).

In the Office Action dated July 3, 2007, the Examiner asserted that the provisional applications 60/14,138 (hereinafter ‘138 application) and 60/101,517 (hereinafter ‘517 application) of Ogilvie teach the feature of “notifying the recipient if the message is unapproved”

of the claimed invention. The Examiner cited, as the basis of the assertion, page 4, lines 5-15 of the '138 application and page 10, lines 1-2 and page 12, lines 1-4 of the '517 application. In the response filed on October 2, 2007, Appellant argued that the cited portions are irrelevant to the claimed feature of "notifying the recipient and storing the message, if the message is approved."

In the third final Office Action dated January 3, 2008, the Examiner finally rejected the claims based on Ogilvie by citing column 1, lines 55-64; column 11, lines 1-6; column 13, lines 1-5; column 14, lines 26-39; and column 13, line 62 through column 14, line 12. Thus, the Examiner's prior rejection was overcome and in response the Examiner cited these portions of Ogilvie. Further, in this January 3, 2008 final Office Action, the Examiner did not address the Appellant's arguments with respect to the previously cited portions (page 4, lines 5-15 of the '138 application and page 10, lines 1-2 and page 12, lines 1-4 of the '517 application).

With regard to Column 1, Lines 55-64, Column 13, Lines 1-5 and
Column 14, Lines 26-39;

As discussed above, none of these passages are in fact prior art as the passages were not disclosed in the parent applications of Ogilvie which antedate the priority date of this application (May 12, 1999).

With regard to Column 11, Lines 1-6

The passage states that "the self-removing message files (206) of the present invention do not require that recipients (202) affirmatively remove unwanted ads or old news from their computer system disk or create a reply message having REMOVE in the subject, to indicate their lack of interest in the subject matter being advertised, to conserve space, and/or to reduce clutter in their inbox." Briefly, this passage merely teaches that recipients (202) do not need to remove unwanted ads from his computer since those unwanted ads are automatically deleted. More specifically, the passage does not teach that even if the unwanted ads are unapproved, the recipient is notified and the unwanted ads are stored. Furthermore, the recipient does not need to be notified and the unwanted ads cannot be stored since the unwanted ads are automatically deleted from the recipient's computer without the recipient's involvement. In contrast, each of

independent Claims 19 and 36 recites *notifying the recipient and storing the message, if the message is unapproved*.

In view of the above, Applicant respectfully submits that the cited passage does not teach or suggest the above-indicated feature of the claimed invention. Further, Appellant reserves the right to challenge whether the cited portion qualifies as prior art.

With regard to Column 13, Line 62 through Column 14, Line 12

This passage teaches that the distributor (222) may be provided with an option to modify a message by removing or adding a self-removal enhancement. Specifically, the passage teaches that if the self-removal enhancement is added, the recipients receive the messages but are not unduly inconvenienced by them. This is because the messages, with the self-removal enhancement added, would be automatically deleted. That is, even if the recipients receive unwanted messages, the recipients are not, and needs not be, notified and the unwanted messages are not stored as the unwanted messages are automatically deleted from the recipient's computer.

Further, the passage teaches that if the self-removal enhancement is removed from a message, the recipient will merely receive the message regardless of whether the message is approved or not. In this situation, the recipient's computer system would allow all messages to continue to come into the system as is. So, this scenario is irrelevant to the claimed feature of "notifying the recipient and storing the message, if the message is unapproved."

In view of the above, Applicant respectfully submits that the cited passage does not teach or suggest the above-indicated feature of the claimed invention. Further, Appellant reserves the right to challenge whether the cited portion qualifies as prior art.

Summary

As discussed above, Olivier does not teach the feature of "notifying the recipient and storing the message, if the message is unapproved" and Ogilvie does not remedy the deficiency of Olivier. Therefore, the combination of the prior art references does not teach or suggest all of the features of each independent claim. Thus, Appellant respectfully submits that no *prima facie* case of obviousness has been established with respect to each independent claim, and thus Claims 19, 29, 30 and 36 are allowable over the prior art of record.

b. Discussion of Patentability of Dependent Claims

Claims 21-28 and 31-35 depend from base Claim 19 or 31, and further define additional technical features of the present invention. In view of the patentability of their base claims, and in further view of their additional technical features, Appellant respectfully submits that the dependent claims are patentable over the cited prior art. Furthermore, Appellant does not necessarily agree with the characterizations of the prior art made by the Examiner in rejecting the dependent claims.

B. Conclusion

In view of the foregoing arguments, Appellant respectfully submits that Claims 19-36 are patentable over the prior art of record.

XIII. APPENDICES

Attached hereto as Appendix A is a copy of finally rejected Claims 19-36 in the present case. Also attached is Appendix B for inclusion of evidence and indicating no evidence is included, and Appendix C for inclusion of information regarding related proceedings and indicating no information regarding related proceedings is included. Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 8/18/08

By: 

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APPENDIX A: CLAIMS
(Claims as finally rejected)

1-18. (Cancelled)

19. A method of handling messages, comprising:
determining if a message is approved for a recipient of the message;
processing the message for subsequent viewing by the recipient if the message is approved; and
notifying the recipient and storing the message, if the message is unapproved.

20. The method of Claim 19, further comprising allowing the recipient to view an unapproved message.

21. The method of Claim 20, further comprising notifying the recipient with a notification message having a link to network data representing a list of unapproved messages for the recipient.

22. The method of Claim 21, wherein the network data comprises markup language data accessible by a computer device of the recipient.

23. The method of Claim 19, further comprising allowing the recipient to set criteria to determine if the message is approved.

24. The method of Claim 23, wherein the criteria includes a sender of the message being on a stored approved list for the recipient.

25. The method of Claim 24, further comprising allowing the recipient to change the criteria.

26. The method of Claim 19, further comprising deleting an unapproved message a predetermined period of time after the notifying.

27. The method of Claim 26, further comprising notifying a sender of the unapproved message of deletion of the unapproved message.

28. The method of Claim 23, wherein the messages and the criteria are stored on an electronic message server.

29. A message processing system, comprising:
means for determining if a message is approved for a recipient of the message;
means for processing the message for subsequent viewing by the recipient if the message is approved; and
means for notifying the recipient and storing the message, if the message is unapproved.

30. A message processing system, comprising:
an electronic message server for receiving and storing electronic messages for a recipient; and
an electronic message manager for processing electronic messages for a recipient to determine if the electronic messages are approved based on stored criteria, sending approved electronic messages for the recipient to a location for access by the recipient, and storing and sending a notification to the recipient of unapproved messages.

31. The message processing system of Claim 30, further comprising an access server for generating a display page with a list of unapproved messages, the notification comprising an electronic message with a link to the display page.

32. The message processing system of Claim 31, wherein the list of unapproved messages includes links to the unapproved messages respectively and which on selection causes transmission of an unapproved message to a recipient's computer device for viewing by the recipient.

33. The message processing system of Claim 32, wherein the criteria includes the sender of a message being on an approved list for the recipient stored on the system.

34. The message processing system of Claim 33, wherein the display page includes a link to at least one display page for displaying and changing the criteria.

35. The message processing system of Claim 33, wherein the display page includes a link for changing the criteria.

36. A computer readable storage medium having code for executing a method of handling messages, the method comprising:

determining if a message is approved for a recipient of the message;

processing the message for subsequent viewing by the recipient if the message is approved; and

notifying the recipient and storing the message, if the message is unapproved.

APPENDIX B: EVIDENCE

None

Application No.: 10/009,575

Filing Date: August 6, 2002

APPENDIX C: RELATED PROCEEDINGS

None

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